

# **REMARKS**

Claims 1, 3-10, 16-19 and 20-28 are in this application.

Claim 17 is currently amended to be a process claim.

Claims 20-28 are newly added to more fully claim the invention.

The examiner rejected claims 1, 3-10 and 16-19 under 35 U.S.C. 103(a) as being unpatentable over Mori, et al (6,208,802) in view of Jeong (6,130,988).

Applicant believes that the examiner has not made out a *prima facie* case of obviousness.

In using Jeong as a reference, the examiner stated:

“Jeong teaches reserving a portion of a memory other than the


disc (330) in figure 3; storing a **return address** (the return address has been interpreted as the address of the menu information 124 in figure 1B) in the memory (col. 4, line 63 col. 5, line 8); and storing the starting and ending **address** (control information 132) of the video in the memory (col. 5, lines 9-27).” *Emphasis added.*

The quoted statement is factually incorrect. Jeong **does not teach** storing a **return address**. As seen from col. 3, lines 9-12 of Jeong, what Jeong stores is **data** that is **not an address**.

Col. 3, lines 9-12 states:

“The menu video data area 124 has video and audio **data** of a still picture or a moving picture of MPEG standard which is displayed on a screen when a menu is to be shown.” *Emphasis added.*

The examiner bears the initial burden of **factually** supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142.

Applicant submits that because Jeong does not store an address at item 124 in Jeong but instead, as stated at col. 3, lines 9-12 of Jeong, stores data that is not an address, there is no *prima facie* case of obviousness made out.

Applicant therefore submits that claims 1-3-20 and 16-19 are currently allowable.

Newly added claims 20-28 are article of manufacture claims that contain the limitations found in claims 1, 3-10 and 16-19 and for this reason applicant submits that these claims are also allowable.


For the above reasons, applicant requests that the above rejection be withdrawn a Notice of Allowance be issued.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 07-1896. The Examiner is invited to contact Applicant's Attorney at (916) 930-3239 if there are any questions or if the Examiner feels that a telephone conference will speed the prosecution of this application.

Respectfully submitted,

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